

Appln No. 09/608,022
Amdt. Dated February 4, 2005
Response to Office action of January 11, 2005

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REMARKS/ARGUMENTS

Claims

The Examiner rejected claims 1-3, 8-31, 36-43, 45-46 and 48. By the present amendment claims 1 and 29 have been amended and claims 22-23 and 45-46 have been cancelled. Therefore claims 1-3, 8-21, 24-31, 36-43, and 48 are now pending in the present application.

Claim Rejections – 35 USC § 103

Claims 1-3, 8-31, 36-43, 45-46 and 48 were rejected under 35 USC 103(a) as being unpatentable over various combinations of Wolff et al (US Patent 6,081,261) in view of Bennett et al (US Patent 5,051,736) in view of Patterson, Jr. et al (US Patent 5,797,002). The rejection is respectfully traversed.

The Examiner appears to have accepted the applicants' previous arguments distinguishing the present claims from Wolff et al in view of Patterson, Jr. et al. However the Examiner conducted a further search and now again rejects all of the pending claims by adding the reference to Bennett et al.

The Applicants assert that the Bennet et al. reference in combination with the previous references still does not teach the claimed invention. Bennet et al disclose a transparent plastic or glass tablet including various layers (40, 42) on which are inscribed position indicating coordinates. The claimed invention however combines much of the functionality described in the three references cited by the Examiner in individual coded sheets of paper called Netpages, which are very different from the devices and methods described in the cited references. The Examiner admits that "Woff, Bennett and Patterson combined do not explicitly disclose printing the coded data on a surface at the same time that the form is printed, printing the coded data which is substantially invisible in the visible spectrum and printing on multiple pages..." The Examiner then dismisses these important distinctions between the cited prior art and the present claims by stating that "[o]fficial notice is taken that these steps are old and well known in the art."

The Applicants traverse the Examiner's assertion of official notice of the above distinctions between the present claims and the cited prior art. The Applicants believe that official notice is not proper here. As stated in the MPEP 2144.03, "Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be 'capable of such instant and unquestionable demonstration as to defy dispute' (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961))." The applicants assert that the use of a single printer to print both visible information and invisible coded data substantially simultaneously is far from being a technology that is "capable of instant and unquestionable demonstration as being well-known." Rather, the applicants assert that such a printer--in combination with a computer system that associates the type and spatial extent of the invisible coded data with the spatial extent of the visible information at the time of printing--did not exist before the present invention of the applicants.

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To further prosecution of this case, which has now been pending for over four and a half years, the Applicants have amended the independent claims to recite explicitly the above features of the present invention--which features clearly distinguish the claims from the prior art. Further, the Applicants assert that the claim limitations added by the present amendment define significant and valuable commercial advantages over the prior art, which advantages are clearly recited in the specification. For example, the specification as filed at page 12, lines 23-24, states that interactive pages of the present invention "... are pages of text, graphics and images printed on ordinary paper, but which work like interactive web pages." The conveniences of such interactive pages--which can be printed quickly by a single printer--were not possible using the systems and methods of the prior art.

Support for the present amendments is found throughout the specification as originally filed. For example, the substantially simultaneous printing of visible inks and invisible infrared inks is found in the specification as filed at page 28, lines 13-14: "This printer simultaneously prints cyan, magenta, yellow, black, and infrared inks as well as paper conditioner and ink fixative." Further, support for the limitation concerning the association in the computer system of the spatial extent of the visible information and the invisible coded data is found in the specification as filed at page 13, lines 7-13: "*The netpage consists of graphic data 2 printed using visible ink, and coded data 3 printed as a collection of tags 4 using invisible ink. The corresponding page description 5, stored on the netpage network, describes the individual elements of the netpage. In particular it describes the type and spatial extent (zone) of each interactive element (i.e. text field or button in the example), to allow the netpage system to correctly interpret input via the netpage. The submit button 6, for example, has a zone 7 which corresponds to the spatial extent of the corresponding graphic 8.*"

Finally, to attempt to reach an understanding with the Examiner concerning the patentable differences between the present invention and the prior art, the Applicants respectfully request a telephone interview with the Examiner. The Applicants will call the Examiner shortly to schedule a mutually convenient time for such an interview.

The Applicants assert that the present application is now in condition for allowance. Reconsideration and allowance of the application is courteously solicited.

Very respectfully,

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